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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/833,342 04/04/97 MAA

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SHALONG MAA, PH.D..PRESIDENT  
SMA INTERNATIONAL, INC.  
816 MCDEAVITT DRIVE, #1077  
ARLINGTON TX 76011

EXAMINER

PARADISO, J

ART UNIT

PAPER NUMBER

3713

22

**DATE MAILED:** 05/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 08/833,342	Applicant(s) MAA
Examiner John Paradiso	Group Art Unit 3713



Responsive to communication(s) filed on 10/27/99

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 35-60 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 35-60 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. In view of the amendments filed 10/27/99, the rejections of the claims under 35 U.S.C. § 112 are hereby withdrawn.

#### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. Claims 35, 37, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by TONG.

TONG discloses an interactive, computer-controlled doll, as described in the previous Office Action, in which actuators to move the doll's body parts. TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

TONG also discloses (in embodiment in Fig. 6) a voice-recognition feature where the user can speak into a microphone and the computer will recognize the words and provide the appropriate signal(s) to the doll.

(See TONG columns 2-4 and figures 1 and 6.)

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**Claim Rejections - 35 USC § 103**

5. Claims 36 and 38-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.

TONG discloses the claimed invention except for the actuators being comprised of a "solenoid means".

However, Applicant is given Official Notice that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

6. Claims 44-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

TONG substantially discloses the claimed invention except for specifically describing the "digital animation-control signal sequence being associated with selected audio speech ... and transmitted to the toy in synchronization with the transmission".

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GASPER ET AL discloses a system for sound-synchronized animation for use in a game, as described in the previous Office Action. GASPER ET AL builds and saves its own dictionary file after determining the proper lip synchronization of an inputted word. GASPER ET AL also teaches different articulations for various sounds: silence, vowels, and consonants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG. Examiner also notes that TONG does disclose the use of voice-recognition software to analyze inputted voice data. Examiner also notes that it is a standard programming technique to store inputted data of all types, including voice recognition data, in memory arrays for temporary use and in text files for permanent storage and later retrieval.

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**Response to Arguments**

7. Applicant's arguments filed 10/27/99 have been fully considered but they are not persuasive.

8. Applicant states on page 1 of his Response that "Checked Box for indicating 'this action is FINAL' ... which is incorrect, as the parties agreed during said telephone conversations on 09/24/99, 10/12/99, and 10/13/99."

Applicant is correct: the cover letter for the previous Office Action was mistakenly marked FINAL (although the previous Offfce Action itself did not state the the action was final). This mistake was acknowledged by phone and prosecution was not concluded, but rather continued in this Action.

9. Applicant states on page 1 of his Response that "the term 'preliminary' is incorrect, since the term 'formal' is shown at the front page of said submission; and ... the date is incorrect, since APPLICANT's record shows that the new Claims were submitted on 7/4/99, a Federal holiday, and the date stamped thereon shall be the next succeeding business day."

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However, the term "Preliminary Amendment" refers to an amendment filed before the application has been examined, that is, before a First Action on the Merits has been mailed. In this case, the amendment under discussion was submitted after a CPA was filed and before the First Action on the Merits had been mailed for that CPA, making it a preliminary amendment. The term preliminary amendment does not mean "informal" - this preliminary amendment was filed and considered as a formal amendment.

The date the preliminary amendment was filed (or entered) was referred to by the Examiner as 7/2/99. That date was quoted because that is the date that is entered on the flap of the file folder for the application under the column "Date Received or Mailed." Examiner will continue to use this date in all correspondence to reduce the potential for confusion.

10. Applicant states on page 2 of his Response that "Claim number '38-4' is certainly incorrect." Examiner agrees - the "-4" was a typographical error and should have read "-42".

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11. Applicant states on page 2 of his Response that "the stamp showing 'Valencia Martin-Wallace, Primary Examiner' [is incorrect, since] ... it was apparent to Applicant that Ms. Wallace is the Supervisory Examiner of the group, and was not acting as a Primary Examiner for the present application."

However, the stamp used by a Primary or Supervisory Primary Examiner does not affect the status of the case. Examiner Paradiso does not have full signatory authority. Valencia Martin-Wallace signed and stamped the case after review and she has full signatory authority. Her status as a Primary or Supervisory Primary Examiner does not affect her full signatory authority.

12. Applicant points out on pages 1-2 of his Response that Examiner has made several typographical errors in his previous Office Action. Examiner regrets any confusion caused by this. However, typographical errors in actions from the Examiner to the Applicant or from the Applicant to the Examiner need not be pointed out except where they directly affect the claims or the Specification or in cases where they cause the communication to be unintelligible.

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13. Applicant points out on page 2 in section (1.1) of his Response that the date of filing of Applicant's Provisional Application predates the patent date of the TONG reference. Applicant is correct. However, the **filing date** of TONG predates the filing date of Applicant's Provisional Application. Accordingly, the 102 rejection has been restated properly (in paragraph 3-4 above) as a rejection under 35 U.S.C. 102(e). Since the claims were rejected in the previous Office action under 35 U.S.C. 102, and since paragraph (e) was obviously the only paragraph in 35 U.S.C. 102 that applied to the instant case, this rejection is not considered new grounds of rejection, only a clarification.

14. Applicant states on pages 2-3 of his Response that "Applicant have [sic] noticed that most of the arguments in the Office Action dated 0802/99 ... are identical to the previous Office Action ... [and] Applicant have [sic] also recognized that the arguments described hereinabove in this section are completely irrelevant to the newly presented claims 35-60. Therefore, unless Examiner provides evidence to the contrary, Applicant concludes that the ACTION is a falsified document, which is also supported by Section (3) hereinbelow. Examiner's lack of response hereto would render his/her agreement hereupon.

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Examiner points out that where an explanation or argument is being maintained from one Office Action into the next, it is appropriate to "cut and paste" from the first to the second action in order to avoid unnecessary or confusing changes in wording and to speed the process of writing the communication. This is in no way to be construed as being non-responsive to Applicant's concerns, since Examiner has showed by this practice that Examiner is sustaining a rejection or argument and that said rejection or argument has not changed. Examiner also notes that the 102 and 103 rejections cited in paragraphs 3-6 above have also been cut and pasted into this Office Action to preserve their integrity and to obviate the need for continued reference to previous Office Actions.

Applicant asserts that Examiner's arguments are not relevant to the new claims 35-60. However, the rejections were made regarding claims 35-60 and Examiner does indeed consider them relevant. Any answers to arguments made herein or in the previous Office Action have been made in response to arguments from Applicant and Examiner also considers those arguments relevant.

Examiner does not fully understand why Applicant would consider the previous Office Action a "falsified document". However, if Applicant is alleging any wrongdoing on the part of the Examiner, those allegations should be brought to the attention of the Director of the USPTO via the Group Director for Technology Center (TC) 3700, Ethyl Rollins-Cross.

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Finally, Examiner's "lack of response" cannot be presumed to "render his/her agreement hereupon". It is more likely that Examiner's "lack of response" on a particular point or argument raised by Applicant is because the particular point or argument is redundant and has already been addressed.

15. Applicant states on page 3, section (3.2) of his Response that "in said Section 16 on Page 9 [of the previous Office Action], Examiner's only argument is '*However, the claims do not recite adjusting the frequency of the image-actuation control in that matter*', such an argument is completely irrelevant to any of the Claims..." .

Examiner points out that his quoted argument was made in response to an argument from the Applicant in a request for Reconsideration, filed 7/2/99 as paper number 13. Examiner was not requiring Applicant to address matter of "adjusting the frequency" but was explaining to the Applicant that the matter was not claimed and was therefore not grounds for rescinding the previous rejection.

16. Applicant states on page 5 section (4.4) of his Response that "Applicant respectfully request [sic] that Examiner clearly describe the pertinence of each reference, and clearly explaine [sic] each rejected claim.

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Examiner has done that in paragraphs 3-6 above.

17. Applicant states on page 5 section 5.2 of his Response that "Examiner have [sic] ignored and is unresponsive to almost all points of arguments in the REMARKS ... which is showing that Examiner agrees with said arguments.

Examiner did answer Applicant's arguments on pages 8-9 of the previous Office Action. As explained in paragraph 14 above, Examiner's "lack of response" cannot be presumed to as a tacit agreement to anything. It is more likely that Examiner's "lack of response" on a particular point or argument raised by Applicant is because the particular point or argument is redundant and has already been addressed.

18. Applicant states on page 5 section 5.3 of his Response that "Therefore, the aforesaid new and different functions, as well as said structural differences, of the present invention render its non-obviousness..".

However, it is unclear which "aforesaid new and different functions" Applicant is referring to. These "different functions" and "said structural differences" are alluded to in several sections of Applicant's response, but are not clearly laid out. As such, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a

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general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Further, Examiner maintains that the rejections of the claims, explained in paragraphs 3-6 above, do indeed address all the functions and structures of the claimed invention.

19. Applicant states on page 6 section 6.3 of his Response that "In present case, TONG and GASPER certainly do not teach or suggest all Claim Limitations of the present application."

However, as explained in paragraph 18 above, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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20. Applicant states on page 6 section 7.4 of his Response that "It is not feasible to simply changed [sic] the DC motor of TONG to a solenoid..".

However, Examiner maintains that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention. Further, since Applicant has not given any reason why such a modification is not feasible, the argument amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

21. Applicant states on page 7 sections 8.6 and 8.7 of his Response that "It is understood that presence of a superior property or property not possessed by the prior art or unexpected or greater than expected result are evidence of non-obviousness. ... In addition, absence of a property which the present invention would have been expected to possess on the teachings of the prior art also renders unobviousness [sic] of the invention.

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However, while this two concepts provide evidence of non-obviousness, they are not always sufficient to prove non-obviousness. More importantly, Applicant has not shown any unexpected results, superior properties, or absent properties which would obviate the rejections detailed in paragraphs 3-6 above.

22. Applicant states on page 7 section 9.2 of his Response that "Furthermore, solenoid is not a commonly used device for actuating a moving part of a doll in the toy industry..".

However, while solenoids may be used less in the toy industry now, they have been used in the past and the rejection is not based on the common use of solenoids but on whether it would be obvious or novel to one skilled in the art at the time the invention was made. Examiner maintains that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

23. Applicant states on page 8 section 10.2 of his Response that "Neither TONG nor GASPER teaches said suggestion or desirability."

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The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG.

24. Applicant states on page 8 section 11.2 and 11.3 of his Response that "There is still no product in the market that is similar to the present invention ... Therefore, there is no evidence for supporting reasonable expectation of success for the proposed modification by the Examiner at the time the present invention was made, which apparently substantiate the conclusions that present invention is nonobvious."

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However, while success or lack thereof can be used as evidence of novelty, it is not sufficient in itself to prove novelty. More importantly, Applicant has not pointed out how success or absence in the market place obviates the rejections detailed in paragraphs 3-6 above and Examiner maintains those rejections.

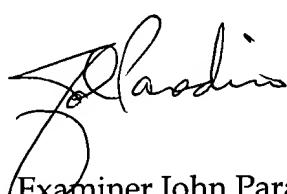
**Conclusion**

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

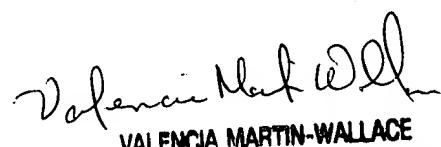
A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to:



Examiner John Paradiso  
Telephone: (703) 308-2825  
Fax: (703) 305-3579/3580



Valencia Martin-Wallace  
VALENCIA MARTIN-WALLACE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

May 5, 2000